

REMARKS**Summary of the Office Action**

Claims 4, 6, 7, 9, 10, 12, 13 and 16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/880,100.

Claims 5, 8 and 11 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/880,100 in view of Ichimura (U.S. 2001/0021145) (hereinafter "Ichimura").

Claims 10-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ichimura.

Claims 4-9 are allowable over the prior art of record if the double patenting rejection is overcome.

Summary of the Response to the Office Action

Applicants have added new claims 17-19 to differently describe embodiments of the disclosure of the instant application's specification. Accordingly, claims 1-19 are currently pending, with claims 1-3 currently withdrawn from consideration.

Double Patenting Rejection

Claims 4, 6, 7, 9, 10, 12, 13 and 16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/880,100. Claims 5, 8 and 11 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claim 1 of copending Application No. 10/880,100 in view of Ichimura. While Applicants do not necessarily concede to this rejection, Applicants submit a Terminal Disclaimer to facilitate allowance of the present application, thereby obviating the double patenting rejections. Accordingly, Applicants request that the double patenting rejections be withdrawn.

The Examiner is thanked for the indication that claims 4-9 are allowable over the prior art of record if the double patenting rejection is overcome. Allowance of claims 4-9 is respectfully requested in light of the above-discussed obviating of the double patenting rejections.

Rejection under 35 U.S.C. § 102(a)

Claims 10-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ichimura. These rejections are respectfully traversed for at least the following reasons.

At page 5 of the Office Action, the Examiner asserts that Ichimura “discloses a position adjustment step of acquiring an image containing reflected light from a solid immersion lens ... and adjusting the position of the solid immersion lens relative to the optical system, with reference to the image.” Such an interpretation of Ichimura is respectfully traversed by Applicants for at least the following reasons.

In the sample observation method described in claim 10 of the instant application, (1) an image containing reflected light from a solid immersion lens is acquired through the optical system, and (2) the position of the solid immersion lens relative to the optical system is adjusted with reference to the image.

Applicants respectfully submit, on the other hand, that in the apparatus disclosed in Ichimura, the reflected light from the optical storage medium, which is an observation sample, is

used for controlling the actuator. See, for example, paragraphs [0027], [0028], and Claim 1 of Ichimura. Applicants note that the Office Action refers in particular to paragraph 0028 of Ichimura at page 5 of the Office Action. With regard to the above-described feature (1) of the methodology described in independent claim 10 of the instant application, the image containing reflected light from the solid immersion lens is not used in Ichimura. Such a feature is not even suggested by Ichimura.

Even further, in Ichimura, the lens holder integrally holds the objective lens and the solid immersion lens with a specific positional relation, and the actuator moves the lens holder, i.e., the actuator integrally moves the objective lens and the solid immersion lens. See, for example, paragraphs [0069] and [0074], Fig. 1, and Claim 1 of Ichimura in this regard. In this configuration, with regard to the above-described feature (2) of the methodology described in independent claim 10 of the instant application, the position of the solid immersion lens relative to the optical system cannot be adjusted in Ichimura. Such a feature is also not even suggested by Ichimura.

Accordingly, Applicants respectfully submit that the apparatus and method disclosed in Ichimura are completely different from the above-described sample observation method of independent claim 10 of the present application.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because Ichimura does not teach, or even suggest, each feature of independent claim 10. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single

prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that dependent claims 11-16 are allowable at least because of their dependence from independent claim 10, and the reasons set forth above.

Newly-Added Claims 17-19

Applicants have added claims 17-19 to differently describe embodiments of the disclosure of the instant application's specification. In the Statement of Reasons for Allowance at page 6 of the Office Action, the Examiner explains that "the prior art fails to teach or suggest inserting a solid immersion lens from a standby position off an optical axis ... to an insertion position including the optical axis." Applicants hereby present new claims 17-19 directed to a sample observation method including features which Applicants deem to be allowable in light of the Examiner's Statement in this regard. Accordingly, allowance of new claims 17-19 is also respectfully requested.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this

application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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Dated: February 27, 2006

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